


Modified PTO/SB/33 (10-05)

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number	
Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450		Q78602	
		Application Number	Filed
		10/780,635	February 19, 2004
		First Named Inventor	
		Yoshihisa USAMI	
		Art Unit	Examiner
		1774	Betelhem SHEWAREGED
WASHINGTON OFFICE 23373 CUSTOMER NUMBER			
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal</p> <p>The review is requested for the reasons(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p><input checked="" type="checkbox"/> I am an attorney or agent of record. Registration number <u>40,641</u></p> <p> Signature</p> <p><u>Jennifer M. Hayes</u> Typed or printed name</p> <p><u>(202) 293-7060</u> Telephone number</p> <p><u>August 31, 2006</u> Date</p>			



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q78602

Yoshihisa USAMI

Appln. No.: 10/780,635

Group Art Unit: 1774

Confirmation No.: 1876

Examiner: Betelhem SHEWAREGED

Filed: February 19, 2004

For: INFORMATION MEDIUM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, and further to the Examiner's Final Office Action dated June 1, 2006, Applicant files this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Applicant turns now to the rejection at issue:

Claims 1-20 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Paulson as evidenced by LeBlanc et al and in view of Ishimaru et al.

Independent claim 1 of the present application recites an optical disk comprising an undercoat layer and a colorant receiving layer in this order on a substrate, wherein at least a part of the periphery of the undercoat layer is coated with the colorant receiving layer.

The Examiner relies on Paulson for the disclosure of an ink jet receiving medium comprising a substrate and an ink receiving layer on the substrate. CD-ROM and CD recordable surfaces are mentioned as suitable substrate surfaces. The Examiner states that the thickness

of such a substrate is within the range specified by ECMA and/or ISO which is said to include 1.5 mm as evidenced by Le Blanc et al. The recording medium further comprises a primer layer between the substrate and the ink receiving layer.

The Examiner recognizes that Paulson does not teach an ink receiving layer containing the claimed components. For this feature, the Examiner relies on Ishimaru as disclosing an ink jet recording medium comprising a support and an ink receptive layer on the support, wherein the ink receptive layer comprises fumed silica having a primary particle size of 3-30 nm. The ink receptive layer is said to be equivalent to the claimed colorant receiving layer. The support comprises a paper and a resin coated on the paper is said to be equivalent to the claimed protective layer. The recording medium further comprises a primer layer under the ink receptive layer.

It is the Examiner's position that Paulson and Ishimaru are analogous art and it would have been obvious to one of ordinary skill in the art to combine the ink receptive layer of Ishimaru with the invention of Paulson to provide a recording surface having enhanced ink absorbing properties and print quality.

With respect to the subject matter of claims 1-4 and 13-16 the Examiner takes the position that it would have been an obvious design choice to vary the coating size or area of the ink receptive layer and/or the primer layer, since such modification would have involved a mere change in the size of a component which is generally recognized as being within the level of ordinary skill in the art.

The main issue at hand is whether the prior art teaches or suggests the feature of the present invention of "at least part of the periphery of the undercoat layer is coated with the colorant receiving layer".

Applicants respectfully submit that the rejection ignores the feature of the present invention of "at least part of the periphery of the undercoat layer is coated with the colorant receiving layer", which is clear error.

None of the references cited teach or suggest the element of "at least a part of the periphery of the undercoat layer is coated with the colorant receiving layer" as recited in the present claims. For example, page 7 of the specification discloses that, as shown in Figures 1A and 1B at least a part of the outer periphery of the undercoat layer is covered by the colorant receiving layer and as shown in Figures 2A and 2B at least a part of the inner periphery of the undercoat layer is covered with the colorant receiving layer. As discussed in the present specification at page 4, lines 13-17, by covering at least a part of the periphery of the undercoat layer with the colorant receiving layer, an ink supplied from an ink jet printer etc. spreads into the covering region, and thus the ink is not retained in the periphery. As a result, the phenomenon in which an image has deeper color in the periphery can be prevented.

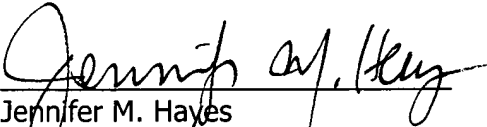
The references are silent as to this feature and do not reasonably provide motivation for one of ordinary skill in the art to modify or combine the references with a reasonable expectation of success since none of the references mention or even recognize the advantages achieved by the present invention wherein at least a part of the periphery of the undercoat layer is coated with the colorant receiving layer. Specifically, Ishimaru et al is directed to a paper material and does not teach or suggest a substrate having a thickness within the recited

range. See, e.g., the working examples and column 6, lines 63-65 of Ishimaru et al. Further, since Ishimaru et al is not directed to the same type of information recording medium as the present invention, Ishimaru et al is not directed to the same problem and does not even recognize the advantages of the claimed invention. Paulson does not remedy the deficiencies of Ishimaru et al in that Paulson also fails to disclose, teach or suggest the element of "at least a part of the periphery of the undercoat layer is coated with the colorant receiving layer" as recited in the present claims or recognize the advantageous effects of the present invention related to this element.

Applicants submit that the Examiner has to initially provide a reasonable basis for asserting that the prior art meets the claims and since the prior art is silent as to the feature of a portion of the periphery of the undercoat layer being coated with the colorant receiving layer and since neither of the cited references recognizes the advantageous effects relating to this element, the Examiner has not met her initial burden.

In view of the above, Appellants respectfully request the Pre-Appeal Brief Conference Panel to withdraw the foregoing rejection in view of clear error in that the prior art references do not disclose, teach or suggest the presently claimed invention.

Respectfully submitted,


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